

Mailed:

**THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB**

August 15, 2003
Paper No. 7
GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Unimed Pharmaceuticals, Inc.

v.

StarCor Pharmaceuticals, Inc.

Opposition No. 124,856 to application Serial No. 76/082,816
filed on July 3, 2000

Lynn A. Sullivan of Leydig, Voit & Mayer, Ltd. for Unimed
Pharmaceuticals, Inc.

Paula A. Willis, Esq. for StarCor Pharmaceuticals, Inc.

Before Cissel, Hohein and Hairston, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

StarCor Pharmaceuticals, Inc. has filed an application
to register the mark "ANDROL XL" for a "non-prescription
nutritional supplement, namely[,] extended release formulation of
androstenedione."¹

Unimed Pharmaceuticals, Inc. has opposed registration
on the ground that "for many years [it] has been engaged in ...

¹ Ser. No. 76/082,816, filed on July 3, 2000, which alleges a date of
first use anywhere and in commerce of July 6, 1999. The term "XL" is
disclaimed.

the pharmaceutical products industry, developing and manufacturing pharmaceuticals for numerous applications including those for various hormone treatments"; that, since a date well prior to the filing date of applicant's application and since at least as early as 1960, opposer and its predecessor in interest have used the mark "ANADROL" on and in connection with steroid hormones; that since the adoption of such mark, opposer and its predecessor in interest "have made continuous use thereof and ANADROL has become a well known pharmaceutical in the industry"; that opposer is the owner of a registration for the mark "ANADROL" for "steroid hormones";² that opposer is also the owner of registrations for the marks "ANDROGEL"³ and "ANDRACTIM"⁴ for, in each instance, a "pharmaceutical preparation for the treatment of testosterone deficiency and/or HIV wasting syndrome";⁵ that applicant's product, "androstenedione[,] is a naturally occurring hormone that serves as a precursor in the biosyntheses of the hormone testosterone"; that applicant's and opposer's products "would likely be directed to the same or at least an overlapping

² Reg. No. 719,177, issued on August 1, 1961, which sets forth a date of first use anywhere and in commerce of November 21, 1960; renewed.

³ Reg. No. 2,232,508, issued on March 16, 1999, which sets forth a date of first use anywhere of November 1995 and a date of first use in commerce of October 9, 1995.

⁴ Reg. No. 2,232,509, issued on March 16, 1999, which sets forth a date of first use anywhere of November 1995 and a date of first use in commerce of October 9, 1995.

⁵ In addition, opposer has pleaded ownership of a pending application, Ser. No. 76/060,361, for registration of the mark "ANDROCREAM" for a "pharmaceutical preparation for the treatment of testosterone deficiency." However, because the record contains no evidence with respect thereto, the application has not been given any consideration.

segment of potential purchasers, that is, consumers who are in need of hormone treatments or supplements for such deficiencies"; and that applicant's use of its mark in connection with its product is likely to cause confusion, mistake or deception with opposer's use of its pleaded marks for its various goods.

Applicant, in its answer, has admitted that opposer "is listed as the current owner of record of the [registration for] the mark ANADROL" and that its product, "androstenedione[,] is a naturally occurring hormone that serves as a precursor in the biosyntheses of the hormone testosterone," but has otherwise denied the salient allegations of the notice of opposition.

The record consists of the pleadings; the file of the opposed application; and, as opposer's case-in-chief, a notice of reliance on (i) certified copies of its pleaded registrations, showing that each registration is subsisting and owned by opposer, and (ii) applicant's answers to opposer's first request for admissions.⁶ Applicant did not introduce any evidence in its

⁶ Although opposer, by its notice of reliance, also seeks to rely on applicant's responses to opposer's first set of requests for production of documents (with "the original documents relating thereto being attached"), such matter has not been given any consideration inasmuch as Trademark Rule 2.120(j)(3)(ii) provides in pertinent part that: "[A] party that has obtained documents from another party under Fed. R. Civ. P. 34 may not make the produced documents of record by notice of reliance alone, except to the extent that they are admissible by notice of reliance under ... [Trademark Rule] 2.122(e) (as official records; or as printed publications, such as books and periodicals, available to the general public in libraries or of general circulation among members of the public or that segment of the public which is relevant under an issue in the proceeding)." Here, none of the documents produced by applicant and offered by opposer meets the exception and thus they are not admissible by means of a notice of reliance. See TBMP §704.11 (2d ed. June 2003). Nevertheless, it is pointed out that even if such documents were to be treated as forming part of the record herein in view of applicant's lack of objection thereto, the result in this proceeding would be the

behalf. Only opposer filed a brief⁷ and neither party requested an oral hearing.

Priority of use is not in issue in this proceeding inasmuch as opposer has proven that, as noted above, each of its pleaded registrations is subsisting and is owned by opposer. See King Candy Co. v. Eunice King's Kitchen, Inc., 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974). Opposer's ownership thereof also serves to establish its standing to bring this proceeding. Id. Thus, the sole issue to be determined in this case is thus whether applicant's "ANDROL XL" mark for a non-prescription nutritional supplement, namely, an extended release formulation of androstenedione, so resembles opposer's "ANADROL" mark for steroid hormones and/or its "ANDRACTIM" and "ANDROGEL" marks for a pharmaceutical preparation for the treatment of testosterone deficiency and/or HIV wasting syndrome as to be likely to cause confusion as to the source or sponsorship of the parties' respective goods.

same because the documents would be probative evidence only as to what they show on their face and would be inadmissible as hearsay if considered for the truth of the matters set forth therein. See TBMP §704.08 (2d ed. June 2003).

⁷ As set forth in TBMP §704.06(b) (2d ed. June 2003): "Factual statements made in a party's brief on the case can be given no consideration unless they are supported by evidence properly introduced at trial. Statements in a brief have no evidentiary value, except to the extent that they may serve as admissions against interest." While the latter is not applicable herein, it is pointed out, however, that there simply is no evidence of record as to, for instance, the statements that "[o]pposer's 'ANADROL' product has been on the market for over 40 years, i.e., since 1960, and is a well recognized and known product in the medical industry" and that "dietary supplements are a natural area of expansion for pharmaceutical companies." In addition, while it is noted that the description of the record in opposer's brief includes references to "Applicant's Answers to Opposer's First Set of Interrogatories," it is

According to the record, the sole information with respect to opposer is that, as noted previously, it is the owner of its pleaded registrations for the marks "ANADROL," "ANDRACTIM" and "ANDROGEL" and that such registrations are subsisting. As to applicant, the record reveals that it "engages in the retail sale of the dietary supplement represented by the mark ANDROL XL" and that it "is also positioned to engage in the wholesale" sale of such product, "although Applicant currently does not have any wholesale customers." (Applicant's Admission No. 3.) Similarly, while applicant denies that it "currently sells its dietary supplement product represented by the mark ANDROL XL to physicians," it admits that it "is positioned to sell" such product "to physician distributors." (Applicant's Admission No. 4.) Likewise, applicant denies that it currently sells its "ANDROL XL" dietary supplement product to "healthcare professionals," but admits that it "is positioned to sell" such product "to health care distributors." (Applicant's Admission No. 5.) Further, while applicant denies that it directly "sells its product represented by the mark ANDROL XL to the general public," it admits that such product "is available to retail consumers of a dietary supplement consisting of the ingredients and recommended uses as provided by the product represented by the mark, ANDROL XL." (Applicant's Admission No. 6.)

Applicant also admits that "ANDROL XL can be described as an extended release formulation of Androstenedione"; that

pointed out that neither a copy thereof nor a notice of reliance thereon was received.

"Androstenedione is a naturally occurring hormone that serves as a precursor in the biosynthesis of testosterone"; that while "ANDROL XL is a product directed to the male population," it "is absolutely contraindicated and should not be taken by males with prostate cancer or breast cancer"; that "ANDROL XL is advertised to help maintain male sexual health"; and that "ANDROL XL is advertised to support the body's natural production of testosterone." (Applicant's Admission Nos. 7, 8, 9, 10 and 11, respectively.)

Upon consideration of the pertinent factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973), for determining whether a likelihood of confusion exists, we find that at least with respect to the marks "ANADROL" and "ANDROGEL," opposer has sustained its burden of proof that confusion as to source or sponsorship is likely to occur. Specifically, as to the *du Pont* factor pertaining to the similarity or dissimilarity of the respective marks in their entirety as to appearance, sound, connotation and commercial impression, we find that opposer's marks "ANADROL" and "ANDROGEL" are substantially similar in each of these respects to applicant's "ANDROL XL" mark.⁸ Given that the term "XL" in applicant's mark, as evidenced by the disclaimer thereof, is at least merely descriptive of its goods, we agree with opposer that the dominant and distinguishing portion of applicant's mark is

⁸ While opposer asserts in its brief that "[a]pplicant's 'ANDROL XL' mark is quite similar ... when compared to all of Opposer's marks," it concedes that such is "especially [so] when compared to Opposer's 'ANADROL' and 'ANDROGEL' marks."

the term "ANDROL." See, e.g., In re Dixie Restaurants Inc., 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); and In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Accordingly, as opposer persuasively observes in its brief (footnote omitted):

[W]hen comparing Applicant's mark to Opposer's "ANADROL" mark, [it is the case that] with the exception of the letter "A" in Opposer's mark, Applicant's "ANDROL" portion of its mark appears to be the exact same word as Opposer's mark. By the same token, Opposer's "ANDROGEL" mark is akin to the dominant "ANDROL" portion of Applicant's mark, as it begins with the same five letters, and ends with the same letter. The addition of the letters "G" and "E" [in Opposer's mark] does not differentiate ... the marks enough to make them not confusingly similar.

Furthermore, both opposer's "ANDROGEL" mark and applicant's "ANDROL XL" mark share the same ending "L" sound when pronounced. In contrast, opposer's "ANDRACTIM" mark contains only the first four letters of applicant's "ANDROL XL" mark and ends in a suffix which is significantly different from the suffix in the "ANDROL" portion of applicant's mark. In consequence of the above, only opposer's "ANDAROL" and "ANDROGEL" marks are so substantially similar overall to applicant's "ANDROL XL" mark that, if used in connection with either the same or closely related goods, confusion as to the origin or affiliation of the respective goods would be likely to occur.

Turning, therefore, to consideration of the goods at issue herein, it is well settled that the registrability of an

applicant's mark must be evaluated on the basis of the identification of goods as set forth in the involved application and the identifications of the goods as recited in any pleaded registrations of record, regardless of what the record may reveal as to the particular nature of the respective goods, their actual channels of trade, or the classes of purchasers to which they are in fact directed and sold. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) and Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987). It is also well established that, absent any specific limitations or restrictions in the identification of goods as listed in an applicant's application and in the identifications of goods as set forth in an opposer's registration(s), the issue of likelihood of confusion must be determined in light of consideration of all normal and usual channels of trade and methods of distribution for the respective goods. See, e.g., CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).

Here, it is plainly the case that, as identified in the respective registration and application, neither opposer's "ANADROL" "steroid hormones" nor applicant's "ANDROL XL" "non-prescription nutritional supplement, namely[,] extended release formulation of androstenedione," contains any limitations as to

the channels of trade, methods of distribution or classes of purchasers to whom such products would be marketed. Such goods thus would be expected to be distributed, for instance, through retail drug stores and nutritional products outlets for purchase by ordinary consumers such as men seeking to maintain healthy testosterone levels. While it would appear that, as identified, opposer's "ANDROGEL" "pharmaceutical preparation for the treatment of testosterone deficiency and/or HIV wasting syndrome" may require, unlike applicant's product, a doctor's prescription in order for a consumer to purchase such goods, it is still the case that both items would be available through, for example, retail drug stores.

The closely related nature of applicant's and opposer's goods is further shown by the fact that applicant's "ANDROL XL" product is an extended release formulation of androstenedione, which as applicant admits "is a naturally occurring hormone that serves as a precursor in the biosynthesis of testosterone." Testosterone is steroid hormone⁹ and thus is the kind of product which is covered by opposer's registration for its "ANADROL" mark, while its "ANDROGEL" registration covers a pharmaceutical

⁹ In this regard we judicially notice that, for example, The American Heritage Dictionary of the English Language (4th ed. 2000) at 1788 defines "testosterone" as "a white crystalline steroid hormone ... produced primarily in the testes and responsible for the development and maintenance of male secondary sex characteristics. It is also produced synthetically for use in medical treatment." It is settled that the Board may properly take judicial notice of dictionary definitions. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n. 7 (TTAB 1981).

preparation for the treatment of a deficiency of testosterone. Given that applicant admits (i) that its "ANDROL XL" non-prescription nutritional supplement is a product which is generally "directed to the male population" (although contraindicated for those with prostate cancer or breast cancer); (ii) that such product "is advertised to help maintain male sexual health"; and (iii) that the product "is advertised to support the body's natural production of testosterone," it is clear that, as asserted in opposer's brief, applicant's non-prescription nutritional supplement is "similar to and complementary to" opposer's goods. The latter, as opposer additionally notes in its brief, plainly are products which "can ... safely be generalized as health care products that are prescribed and used for maintaining proper testosterone and hormone levels" and therefore may properly be characterized as "intrinsically related" to "the testosterone treatment products of Applicant." All of the goods at issue herein consequently are closely related in that they would typically be purchased by adult males in, for instance, retail drug stores, and used for the treatment of a deficiency in, or maintenance of a proper level of, testosterone.

Accordingly, we conclude that men desiring to maintain sexual health through the use of a non-prescription nutritional supplement which functions to support the body's natural production of testosterone, and who previously have been prescribed or otherwise are familiar with the use of opposer's "ANADROL" steroid hormones and/or its "ANDROGEL" pharmaceutical

Opposition No. 124,856

preparation for the treatment of testosterone deficiency, are likely to reasonably believe, upon encountering the substantially similar mark "ANDROL XL" used in connection with applicant's extended release formulation of the testosterone precursor androstenedione, that such closely related products emanate from, or are sponsored by or affiliated with, the same source.

Decision: The opposition is sustained and registration to applicant is refused.